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| 10/034,212   | 01/03/2002  | Chaim Gilon          | GILON=1             | 7766             |
| 1444   | 7590        | 01/13/2005           | EXAMINER            |                  |
| BROWDY AND NEIMARK, P.L.L.C.<br>624 NINTH STREET, NW<br>SUITE 300<br>WASHINGTON, DC 20001-5303 |             |                      | EPPERSON, JON D     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1639                |                  |

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/034,212

**Applicant(s)**

GILON, CHAIM

**Examiner**

Jon D Epperson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-5 (in part), 6, 7-8 (in part), 9-19, 20 (in part) and 21-34.

## DETAILED ACTION

### *Status of the Application*

1. Receipt is acknowledged of a Response to a Restriction Requirement, which was dated on October 21, 2004.

### *Status of the Claims*

2. Claims 1-34 were pending in the present application.
3. Applicant's response to the Restriction and/or Election of Species requirements in the 10/21/04 Response is acknowledged (Applicant elected with traverse Group I, claims 1-11 and 20) and claims 12-19 and 21-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. **Please note:** claims 1-11 and 20 are also withdrawn "in part" to the extent that claims 1-11 and 20 do not read on Applicants' elected ring structure (i.e., scaffold I). Applicants will NOT be restricted to a specifically defined ring structure (i.e., see 10/21/04 Response, page 2, wherein Applicants elected scaffold 1 with X and Y = S; m and n =6), but rather to the broader "generic" scaffold 1 shown, for example, in claim 5. Thus, the restriction requirement drawn to a single ring structure is withdrawn in favor of a restriction to the broader generic scaffold 1 as shown in claim 5. Applicants' species election, however, remains in effect (see below i.e., Response to Restriction and/or Election of Species).

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4. Applicant's *specifically* elected species (e.g., see 10/21/04 Response, page 2 i.e., scaffold 1 wherein X and Y are each S; m and n are each 6; R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup> and R<sup>4</sup> are each H; R<sup>6</sup> and R<sup>7</sup> are each benzyl; R<sup>8</sup> is benzyloxycarbonyl; and L is NH<sub>2</sub>) was searched and was not found in the prior art. Thus, the search was expanded to non-elected species, which *were* found in the prior art, see rejections below. Also, see MPEP § 803.02 (emphasis added):

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. *The prior art search, however, will not be extended unnecessarily to cover all nonelected species.* Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

5. Claims 6, 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 6 (see below i.e., *Response to Restriction and/or Election of Species*).

6. Therefore, claims 1-5 (in part), 7-8 (in part) and 20 (in part) are examined on the merits in this action (i.e., to the extent that they read on formula I in claim 5).

#### ***Response to Restriction and/or Election of Species***

7. Applicant's election of Group I and scaffold 1 **with traverse** is acknowledged.

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8. The traversal is on the ground(s) that [1] "... the requirement is extremely burdensome to the applicant, indeed onerous ... when it is considered how interrelated all aspects of the present invention are ... the PTO can combine some groups to reduce the burden on applicant" (e.g., see 3/30/04 Response, page 2, first full paragraph), [2] "... MPEP 803 requires an examiner to search and examine plural inventions, even though the requirement is correct, if it would not constitute a 'serious burden' to do so ... Groups VIII, IX and X are classified in the same location as the elected Group I ... therefore no 'serious burden' [is required]" (e.g., see 3/30/04 Response, page 2, second full paragraph), [3] "applicant further requests rejoining after the examiner has had the opportunity to evaluate the claimed compounds" (e.g., see 3/30/04 Response, paragraph bridging pages 2-3; see also 10/21/04 Response, pages 3-4), [4] "... Again, the requirement is onerous [with regard to the 'ring' election] ... generic groups can be defined which do not impose such a burden on the applicant, and yet also would not impose as serious burden on the examiner" (e.g., see 3/30/04 Response, paragraph bridging pages 3-4).

9. These arguments were fully considered but were not found persuasive. The Examiner's position is that [1, 4] there are two criteria for a proper restriction according to MPEP § 803 including: (i) the inventions must be independent or distinct as claimed and (ii) there must be a serious burden on the Examiner if restriction is required. Thus, the burden to Applicants is not relevant to the issue restriction and, as a result, this argument is moot, [2] As stated in the Restriction Requirement dated September 30, 2003, these inventions (Groups I-X and the "Ring" structure election) have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and/or products would

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require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden for the Office. However, the Examiner has attempted to “define” a broader generic group which should “not impose such a burden on the applicant, and yet also would not impose a serious burden on the examiner” as requested (e.g., see 3/30/04 Response, paragraph bridging pages 3-4) by NOT restricting Applicants to a specifically defined ring structure (i.e., see 10/21/04 Response, page 2, wherein Applicants elected scaffold 1 with X and Y = S; m and n =6), but rather to the “generic” scaffold 1 shown, for example, in claim 5. Scaffolds 1-4 require different starting materials, diverse methods of production and produce different library products as outlined in schemes 1-4 of the specification (e.g., the molecules can be separately classified, and the searches are divergent i.e., different structure would have to be searched which is unduly burdensome). Finally, the Examiner notes that Groups I, VIII, IX and X do not have to fall within different classifications in order to be considered patentably distinct. See MPEP § 817(D)(3-5). The Examiner can require restriction even when the inventions fall within the same classification provided that the claimed inventions represent divergent subject matter, divergent fields of search or show that search terms for one groups are not required for the other. For example, according to MPEP § 817(D)(3-5) reasons for insisting upon restriction include: (1) Separate status in the art, (2) Different classification, (3) Same classification but recognition of divergent subject matter, (4) Divergent fields of search, or (5) Search required for one group not required for the other. As stated in the 9/30/04 Restriction (e.g., see paragraphs 4-9), a divergent search would be required because the Groups represent divergent subject matter, [3] The Examiner will follow the rejoinder practiced as outlined in MPEP § 821.04:

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Applicant is reminded that where applicant elects claims directed to a product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

10. Applicant's election of species with traverse is also acknowledged (e.g., see 10/21/04 Response, page 2).

11. The election of species traversal is on the ground(s) that "... it creates an unreasonable burden on the applicant, and it would not cause a serious burden to the PTO to examine additional compounds which share the same overall configuration" (see Paper No. 7, page 2).

12. These arguments were fully considered but were not found persuasive. As stated previously in the 9/30/03 Restriction, the different species would require different searches and there is no expectation that the searches would be coextensive. Thus, the examiner maintains that this does create an undue search burden. Contrary to Applicants' assertion, these species do not share the same "overall configuration" (e.g., see claim 7 wherein the configuration of the ring



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changes depending on the substitutions set forth for X and Y). Thus the species are distinct, each from the other, because the structures and modes of action of each of the species encompassed are different. They would also differ in their reactivity and/or mechanism and/or the products made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

Furthermore, the Examiner previously stated that should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. This has not been done.

13. As a result, the restriction requirement and/or election of species is still deemed proper and is therefore made FINAL.

#### ***Information Disclosure Statement***

14. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98 (b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on the form PTO-892, they have not been considered.

### *Specification*

15. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claims Rejections - 35 U.S.C. 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 3-5, 8, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Reichwein et al. (Reichwein, J. F.; Liskamp, R. M. J. "Synthesis of Cyclic Dipeptides by Ring-Closing Metathesis" *Eur. J. Org. Chem.* **2000**, 2335-2344).

For *claims 1, 4, 5, 8*, Reichwein et al. (see entire document) disclose the synthesis of compound 9(c) (see page 2337, scheme 5), which anticipates the claimed invention. In this scenario, X and Y are CH=CH; n and m are both equal to 3 wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup> and R<sup>4</sup> are all hydrogen; W is a covalent bond; (a) is -N(CHR<sup>6</sup>COL)-; (b) is -N(COR<sup>8</sup>)-CHR<sup>7</sup>-; Z is -C=O; R<sup>8</sup> is a methyl (i.e., an un-substituted alkyl); R<sup>7</sup> is hydrogen; R<sup>6</sup> is hydrogen; L is Phe-OMe (i.e., NHR<sup>5</sup> wherein R<sup>5</sup> is a substituted alkyl or a side chain of

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naturally or artificially occurring amino acid as well as a derivative or mimic of such a side chain).

For *claim 3*, Reichwein et al. disclose  $\text{--}\underline{\text{N}}(\text{CHR}^6\text{COL})\text{--}$  for (a), which provides one atom to said scaffold, and  $\text{--}\underline{\text{N}}(\text{COR}^8)\text{--}\underline{\text{CHR}}^7\text{--}$  for (b), which provides two atoms to said scaffold (e.g., see page 2337, scheme 5; wherein the underlined atoms above are the ones provided to said scaffold).

For *claim 20*, Reichwein et al. do not disclose the “use” of the claimed compound for agriculture. However, “[t]he recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber* 44 USPQ2d 1429 (Fed. Cir. 1997). In addition, where the claimed and prior art products are identical or substantially identical in structure or composition (as shown above), or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01. Here, Applicants’ intended use limitation (i.e., use in agriculture) does not distinguish the claim over the prior art because “intended use language” is not generally afforded any patentable weight (e.g., see *In re Schreiber* above) or, in the alternative, because compound 9(c) of the Reichwein et al. reference would inherently be “capable” of performing the intended use in accordance with MPEP § 2112.01 as the

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structure of this compound appears to be identical to compounds falling within the scope of the claims (see above).

17. Claims 1-5, 8 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Callahan et al. (WO 93/09133) (Date of Patent is **May 13, 1993**).

For *claims 1-5 and 8*, Callahan et al. (see entire document) disclose, for example, the synthesis of compound 12 (e.g., see page 15), which anticipates the claimed invention. In this scenario, X and Y are both CH<sub>2</sub>; n and m are both equal to 1 wherein R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup> and R<sup>4</sup> are all hydrogen; W is a covalent bond; (a) is -N(CHR<sup>6</sup>COL)-; (b) is -N(COR<sup>8</sup>)-CHR<sup>7</sup>-; Z is -C=O; R<sup>8</sup> is an un-substituted alkyl (i.e., the methyl group); R<sup>7</sup> is a substituted alkyl (i.e., propyl substituted with gaunidinium group); R<sup>6</sup> is hydrogen; L is Asp-NHPh (i.e., NHR<sup>5</sup> wherein R<sup>5</sup> is a substituted alkyl or a side chain of naturally or artificially occurring amino acid as well as a derivative or mimic of such a side chain).

For *claim 3*, Callahan et al. disclose -N(CHR<sup>6</sup>COL)- for (a), which provides one atom to said scaffold, and -N(COR<sup>8</sup>)-CHR<sup>7</sup>- for (b), which provides two atoms to said scaffold (e.g., see page 15, compound 12; wherein the underlined atoms above are the ones provided to said scaffold).

For *claim 20*, Callahan et al. do not disclose the “use” of the claimed compound for agriculture. However, “[t]he recitation of a new intended use for an old product does not make a claim to that old product patentable.” In re Schreiber 44 USPQ2d 1429 (Fed. Cir. 1997). In addition, where the claimed and prior art products are identical or

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substantially identical in structure or composition (as shown above), or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP § 2112.01. Here, Applicants’ intended use limitation (i.e., use in agriculture) does not distinguish the claim over the prior art because “intended use language” is not generally afforded any patentable weight (e.g., see *In re Schreiber* above) or, in the alternative, because compound 12 of the Callahan et al. reference (see page 15) would inherently be “capable” of performing the intended use in accordance with MPEP § 2112.01 as the structure of this compound appears to be identical to compounds falling within the scope of the claims (see above).

***Claims Rejections - 35 U.S.C. 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1, 2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. For *claims 1 and 5*, the terms “substituted alkyl”, “aryl” and “heterocycl” are vague and/or indefinite. For example, the specification defines “substituted alkyl” as an “alkyl having one or more non-interfering substituents” (e.g., see page 13, lines 22-23). As with any other claim limitation, functional language is acceptable so long as it sets definite boundaries on the patent protection sought (see *In re Barr* 170 USPQ 33 (CCPA 1971)). Here, Applicants define a substituted alkyl, at least in part, by a functional property (i.e., the ability of the substitution to act as a “non-interfering” substituent). However, the boundaries of this functional language cannot be determined because the point of reference to which the interference refers has not been set forth in the specification. For example, does the non-interference refer to the chemical synthesis of the compound, the ability of the compound to bind to a receptor, the ability of the compound to remain soluble in a particular solvent, etc.? Consequently, a person of skill in the art could not immediately envision all the possible chemical structures for a substituted alkyl because the function is not fully defined (i.e., a person of skill in the art would not know what the interference is referring to). Likewise, the terms “aryl” and “heterocycle” are also defined, at least in part, with this indefinite “non-interfering” terminology (e.g., see terms recited in the Glossary section of the specification). Thus, the metes and bounds of the claimed invention cannot be determined. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169.

B. For *claims 1-2*, formula (B) is vague and indefinite because the R<sup>5</sup> group is not defined. Consequently, the metes and bound of the claimed invention cannot be determined.

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C. For *claim 5*, the metes and bounds of the “*derivatives and mimics of such side chains [referring to amino acids]*” cannot be determined because applicants have only provided examples of molecules to be included and not a means for determining whether any given molecule is encompassed by the term or not. In addition, a claim to a material defined solely in terms of what it can do (e.g., the ability to mimic), or a property thereof, does not particularly point out the claimed invention. A person of skill in the art cannot immediately envision all the possible chemical structures for a side chain with this function because the standards by which the particular side chain is to be judged as a mimic has not been set forth. Thus, the metes and bounds of the claimed invention cannot be determined. See *ex parte Pulvari* (POBA 1966) 157 USPQ 169.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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19. Claim 1-5, 7-8 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 22-23 of copending U.S. Patent Application No. 10/882,636 (referred to herein as '636).

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examiner application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1986).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the recited claims in each application encompass embodiments (species of heterocyclic compounds) that are the same (e.g., the compounds of claim 12 in '636 are identical to the compounds of formula I of claim 5 in the present application when the R groups, m and n, X and Y variables are the same). Thus, the heterocyclic compounds in each of the recited cases have overlapping members and the compounds encompassed by the claims in each of the applications could be the same. In addition, the dependent claims of '636 teach toward the most preferred embodiments of the currently claimed invention. Thus, the compounds instantly claimed would be anticipated or obvious over those claims in 10/882,636.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.  
January 6, 2005

  
PADMA SHRI PONNALURI  
PRIMARY EXAMINER